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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Corning Tropel Corporation

Serial No. 76/224,870

Paul R. A. Burke for Corning Tropel Corporation.

Susan Stiglitz, Trademark Examining Attorney, Law Office  
103 (Dan Vavonese, Acting Managing Attorney).

Before Hohein, Hairston and Walters, Administrative  
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Corning Tropel Corporation seeks to register the mark  
shown below,

μCAT

for "catadioptric micro-objective lenses using deep UV radiation and having submicrometer resolution and high numerical apertures for microlithography."<sup>1</sup>

The Trademark Examining Attorney has refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark, when used in connection with applicant's goods, is merely descriptive thereof. When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs on the case.

The Examining Attorney contends that "the [mark] is merely descriptive of the applicant's goods because its component parts refer immediately to characteristics of the goods, which are that the goods consist of catadioptric micro-objective lenses used in microlithography. (Brief, p. 2). The Examining Attorney maintains that applicant has conceded the descriptiveness of the mark by virtue of the following statement on page 1 of applicant's application:

The mark consists of the Greek letter  $\mu$  (Mu) together with the word CAT, but will probably be recognized and pronounced by those to whom the products will be sold as "MICRO CAT".

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<sup>1</sup> Application Serial No. 76/224,870, filed March 16, 2001, alleging first use anywhere and first use in commerce as least as early as June 30, 2000.

In support of the refusal, the Examining Attorney submitted an excerpt from The Random House Webster's Unabridged Dictionary (2001) which defines "mu" as: "1. *the 12<sup>th</sup> letter of the Greek alphabet*", and "3. *micron*"; an Internet printout of "Metric prefixes" which lists "(mu)" as: "*micro (Latin micro or Greek mikros, 'small')*"; and an excerpt from the Academic Press Dictionary of Science and Technology wherein "catadioptric" is defined as:

*Optics, describing an optical system that operates by both reflection and refraction, used to reduce aberrations in telescopes. Thus, catadioptric telescopes, catadioptric imaging system.*

Further, the Examining Attorney made of record several Internet printouts and an excerpt from the NEXIS database which show use of the term "cat" to refer to catadioptric lenses in telescopes and shooting scopes. The following are examples:

The scopes using mirrors are often referred to as catadioptric scopes ("cat" for short) and they tend to be shorter and thicker in diameter than scopes using prisms. You will see cat scopes toted by a handful of birders.  
(The Boston Globe, April 17, 1997); and

Most of the mirror scopes you will see in the field are actually compound telescopes, catadioptrics (Cats for short), which use a combination of lenses and mirrors to form the image.

(<http://betterviewdesired.com/Cats.html>)

Finally, with her appeal brief, the Examining Attorney submitted two additional definitions. The first is an excerpt from Merriam-Webster Dictionary wherein "*catadioptric*" is defined as "*belonging to, provided by, or involving both the reflection and refraction of light;*" and the second is an excerpt from The American Heritage Dictionary of the English Language (4<sup>th</sup> ed. 2000) wherein "*catadioptric*" is defined as: "*Of or relating to an optical system that uses both reflective and refractive optical devices.*"<sup>2</sup>

Applicant, in urging reversal of the refusal to register, argues that "[a]pplicant will agree that the combined term  $\mu$ CAT is suggestive of certain aspects of its goods including both its applicability for microlithography and the micro-objective feature of the goods, however, because the mark suggests certain aspects [of applicant's goods] that does not mean it is merely descriptive of the goods." (Brief, p. 6). According to applicant, at most, "the mark implies a catadioptric lens and a small dimension," however, "[t]his is far too little to describe to an interested person the nature or purpose of the lens."

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<sup>2</sup> We take judicial notice of these definitions as requested by the Examining Attorney. See *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.* 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

(Response, p. 2.) Finally, applicant argues that the Examining Attorney's evidence shows that CAT is recognized as an abbreviation for the word "catadioptric" as applied to telescopes, but the evidence does not show that CAT has any meaning or is used in the microlithography trade. Applicant acknowledges that persons with a background in optics would possibly recognize a "crossover from terminology in the field of telescopes to cameras to applications in microlithography," but argues that the Examining Attorney has not demonstrated any such crossover or recognition by persons in applicant's field which involves the inspection process used in the manufacturing of semiconductor/electronic components.<sup>3</sup>

A mark is merely descriptive if it "forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods." *Abercrombie & Fitch Company v. Hunting World, Incorporated*, 537 F.2d 4, 189 USPQ 759, 765 (2<sup>nd</sup> Circuit 1976) (emphasis added). See also, *In re Abcor Development Corporation*, 616 F.2d 525, 200 USPQ 215 (CCPA 1978). Moreover, in order to be merely descriptive, the mark must immediately convey information as to the

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<sup>3</sup> We note that applicant offered to disclaim the term CAT apart from the mark as shown, but the Examining Attorney found that such a disclaimer was inappropriate because the mark is unitary in nature.

ingredients, qualities or characteristics of the goods or services with a "degree of particularity." See *In re TMS Corporation of the Americas*, 200 USPQ 57, 59 (TTAB 1978).

Further, it is well established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods. See *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995).

It has long been acknowledged that there is often a very narrow line between terms which are merely descriptive and those which are suggestive, and the borderline between the two is hardly a clear one. See *In re Atavio Inc.*, 25 USPQ2d 1361 (TTAB 1992).

The Examining Attorney bears the burden of showing that a mark is merely descriptive of the identified goods or services. See *In re Merrill, Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).

In this case, we find the Examining Attorney has not established that, when applied to applicant's goods, µCAT immediately describes, without conjecture or speculation, significant characteristics of the goods. We believe that

some cogitation or mental processing would be required for prospective customers of applicant's goods to readily perceive the significance of  $\mu$ CAT as it pertains to catadioptric micro-objective lenses using deep UV radiation and having submicrometer resolution and high numerical apertures for microlithography. With respect to the Examining Attorney's contention that applicant has conceded that the mark is merely descriptive, we disagree. Although, as applicant acknowledges, persons encountering the  $\mu$ CAT mark may well "recognize" or pronounce it as MICRO CAT, this does not mean they would immediately understand the precise nature of applicant's lenses.

Also, as noted by applicant, absent from this record is any evidence of use of the term CAT by others to refer to lenses in the microlithography field.

Finally, we recognize that we must resolve whatever doubt we may have regarding the merely descriptive character of the mark in favor of applicant and the mark should be published for opposition. See *In re Rank Organization Ltd.*, 222 USPQ 324, 326 (TTAB 1984) and cases cited therein.

**Decision:** The refusal to register under Section 2(e)(1) of the Act is reversed.